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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,978	06/17/1999	JOHN C. WEBBER	1365-021C	5936

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STANDLEY LAW GROUP LLP
495 METRO PLACE SOUTH
SUITE 210
DUBLIN, OH 43017

EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/334,978

Applicant(s)

WEBBER ET AL.

Examiner

Natalie A. Pass

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Art Unit: 3626

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 26 August 2003. Claims 1, 18 and 21 have been amended. Claims 2, 5-9, 11, 13, 19-20, 22, and 24 have been previously amended. Claim 10 has been cancelled. Claims 1-9, 11-26 remain pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 9, 11-13, 18-19, 21, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., U.S. Patent Number 5, 715, 448 in view of Shavit et al., U.S. Patent Number 4, 799, 156, and further in view of King, Jr. et al, U.S. Patent Number 5, 319, 542 for substantially the same reasons given in the previous Office Action (paper number 10). Further reasons appear hereinbelow.

(A) Claim 1 has been amended to recite the limitation of "in accordance with a request from said customer computer" in lines 17-18.

Art Unit: 3626

As per this new limitation, Suzuki, Shavit, and King teach an electronic shopping system and method comprising transmitting real time or interactive updates to said product information in accordance with a request from said customer computer (Suzuki; column 8, lines 59-64, Figure 9, Item S12), (Shavit; column 6, line 53 to column 7, line 5, column 8, lines 5-15, column 11, lines 10-21, column 12, line 42 to column 13, line 14, column 14, lines 50-62), (King; column 2, lines 1-11, column 3, line 15 to column 4, line 2, column 5, lines 1-55).

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 10, section 4, pages 2-7), and incorporated herein.

The motivations for combining the respective teachings of Suzuki, Shavit, and King are as given in the rejection of claim 1 in the prior Office Action (paper number 10) and incorporated herein.

(B) Claim 18 has been amended to recite the limitation of "in response to a request for updated product information from said customer computer" in lines 23-24.

As per this new limitation, Suzuki, Shavit, and King teach an electronic shopping system and method comprising updating in real time or interactively said product information in accordance with a request for updated product information from said customer computer (Suzuki; column 8, lines 59-64, Figure 9, Item S12), (Shavit; column 6, line 53 to column 7, line 5, column 8, lines 5-15, column 11, lines 10-21, column 12, line 42 to column 13, line 14, column 14, lines 50-62), (King; column 2, lines 1-11, column 3, line 15 to column 4, line 2, column 5, lines 1-55).

The remainder of claim 18 is rejected for the same reasons given in the prior Office Action (paper number 10, section 4, pages 2-7), and incorporated herein.

The motivations for combining the respective teachings of Suzuki, Shavit, and King are as given in the rejection of claim 1 in the prior Office Action (paper number 10) and incorporated herein.

(C) Claim 21 has been amended to recite the limitation of "and a request from said customer computer" in lines 17-18.

As per this new limitation, Suzuki, Shavit, and King teach an electronic shopping system and method comprising real time or interactive updates to said product information obtained in accordance with a request from said customer computer (Suzuki; column 8, lines 59-64, Figure 9, Item S12), (Shavit; column 6, line 53 to column 7, line 5, column 8, lines 5-15, column 11, lines 10-21, column 12, line 42 to column 13, line 14, column 14, lines 50-62), (King; column 2, lines 1-11, column 3, line 15 to column 4, line 2, column 5, lines 1-55).

The remainder of claim 21 is rejected for the same reasons given in the prior Office Action (paper number 10, section 4, pages 2-7), and incorporated herein.

The motivations for combining the respective teachings of Suzuki, Shavit, and King are as given in the rejection of claim 1 in the prior Office Action (paper number 10) and incorporated herein.

(D) Claims 3, 4, 9, 11-13, 19, and 26 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 10, section 4, pages 2-7), and incorporated herein.

Art Unit: 3626

4. Claims 2, 14, 15, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki, U.S. Patent Number 5, 715, 448 in view of Shavit et al, U.S. Patent Number 4, 799, 156, and King, Jr. et al, U.S. Patent Number 5, 319, 542 as applied to claims 1, 11, and 21 above, and further in view of Atcheson, U.S. Patent Number 5, 583, 763 for substantially the same reasons given in the previous Office Action (paper number 10). Further reasons appear hereinbelow.

(A) Claims 2, 14, 15, 22, 23 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 10, section 5, pages 7-8), and incorporated herein.

5. Claims 5-8, 16-17, 20, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki, U.S. Patent Number 5, 715, 448, in view of Shavit et al, U.S. Patent Number 4, 799, 156 and King, Jr. et al, U.S. Patent Number 5, 319, 542 as applied to claims 1, 11, 18 and 21 above, and further in view of Filepp, U.S. Patent Number 5, 347, 632 for substantially the same reasons given in the previous Office Action (paper number 10). Further reasons appear below.

(A) Claims 5-8, 16-17, 20, 24-25 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 10, section 6, pages 8-11), and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 26 August 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 26 August 2003.

(A) At pages 12-13 of the 26 August 2003 response, Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added features in the 26 August 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Suzuki, Shavit, King, Atcheson, and Filepp, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 10), and incorporated herein. In particular, Examiner notes that the recited features of real time or interactive updates to product information based on customer requests are taught by the combination of applied references (Suzuki; column 8, lines 59-64, Figure 9, Item S12), (Shavit; column 6, line 53 to column 7, line 5, column 8, lines 5-15, column 11, lines 10-21, column 12, line 42 to column 13, line 14, column 14, lines 50-62), (King; column 2, lines 1-11, column 3, line 15 to column 4, line 2, column 5, lines 1-55).

(B) At page 13-14 of the 26 August 2003 response, Applicant argues the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a

Art Unit: 3626

secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In particular, as demonstrated in the rejections of newly amended Claims 1, 18, and 21 above, the combined cited references of Suzuki, Shavit, King, Atcheson, and Filepp, teach real-time or interactive or immediate updates to product information based on customer or user requests, and further including concurrent interactive business transaction sessions between different users (Shavit; Abstract).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

Art Unit: 3626

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's

Art Unit: 3626

combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Conclusion

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

Art Unit: 3626

or faxed to:

(703) 305-7687.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

November 4, 2003

Joseph Thomas
JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600